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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,311	11/27/2001	James R. Shay	021737-001410US	3014
20350	7590	08/10/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SANTOS, PATRICK J D	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/997,311	Applicant(s) SHAY ET AL.	
	Examiner Patrick J Santos	Art Unit 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5 / 3-7-2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,870,089 issued to Fabbio et al. (hereafter Fabbio '089) in view of U.S. Patent No. 5,031,214 issued to Dziewit et al. (hereafter Dziewit '214) and in further view of the web page, www.legalstar.com as archived by the WAYBACK MACHINE (TM) (www.archive.org) on April 21, 1999 (hereafter LegalStar '99).

Claim 1:

Regarding Claim 1, Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses: a computer-implemented method comprising:

- storing a plurality of alterable electronic documents on a computer system (Fabbio '089: col. 2, lns. 56-65); and
- generating a first signal indicating that one or more of the electronic documents are to be filed (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating electronic documents are to be filed).

However, Fabbio '089 does not explicitly disclose:

- automatically locking the one or more electronic document into a non-editable form;
- the electronic documents are associated with a patent application;
- or that the filing of the electronic documents is with a patent office.

Dziewit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziewit '214 discloses: a computer-implemented method of controlling document edits (Dziewit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) including:

- automatically locking the one or more electronic document into a non-editable form (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55).

However, Dziewit '214 does not disclose that the electronic documents are associated with a patent application; or that the filing of the electronic documents is with a patent office.

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to apply the electronic document locking means of Dziewit '214 to the electronic document package distribution means of Fabbio '089. The motivation to combine is suggested by Dziewit '214 which discloses that use of the electronic document locking means of Dziewit '214 provides the advantage of guaranteeing the "legal document authentication and authenticity requirements traditionally associated with printed documents" (Dziewit '214: col. 3, lns. 14-22) such as with documents in the electronic document package means of Fabbio '089.

It would have been further obvious to a person having ordinary skill in the art to apply the Fabbio '089 and Dziewit '214 combination for electronic filing of patent documents as per LegalStar '99. The motivation to combine is suggested by Dziewit '214 which discloses that use of Fabbio '089 and Dziewit '214 in combination provide the advantage of rendering electronic documents such as that of LegalStar '99 the degree of trust associated with paper documents, thus providing for the automation of the patent application process (Dziewit '214: col. 1, ln. 60 to col. 2, ln. 2).

Claims 2-5, 9, and 11:

Regarding Claims 2-5, 9, and 11, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 1 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 2) further comprising storing the one or more electronic documents in a package prior to generating the first signal (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that “one or more pieces of information” reads on one or more electronic documents – also see Dziewit '214: col. 1, lns. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 3) further comprising performing a manual verification of the locked electronic documents prior to filing the documents in the patent office (Dziewit '214: col. 10, lns. 1-12 – note that individual document editing, which reads on a manual verification of an electronic document, is prior to the communications step described in col. 10, lns. 15-58).

- (Claim 4) further comprising electronically transmitting the electronic documents to the patent office (Fabbio '089: col. 3, Ins. 4-23 – note that Fabbio '089 supports forwarding an electronic document package to an arbitrary destination, and explicitly supports targeting a mail queue that will electronically transmit the electronic documents – also see Dziewit '214: col. 1, Ins. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 5) further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents (Fabbio '089: col. 6, Ins. 6-8; Dziewit '214: col. 14, Ins. 26-32; col. 14, Ins. 51-55 – Fabbio '089 supports notifications in general as a package attribute which reads on a first signal; and combined with Dziewit '214's support of locking reads on locking an electronic document in response to a first signal – also see Dziewit '214: col. 1, Ins. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 9) further comprising generating a second signal indicating that the one or more of the electronic documents are final draft documents (Fabbio '089: col. 6, Ins. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating that the electronic documents are final drafts – also see Dziewit '214: col. 1, Ins. 33-60 which outline a generic paper transaction to be automated by Dziewit '214).
- (Claim 11) wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an office

action, inventor declaration, assignment, power of attorney, or patent drawings
(LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

Claim 6:

Regarding Claim 6, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 5 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose wherein the automatically locking includes automatically converting the one or more electronic documents from a first document type to a locked image file (Fabbio: '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55).

Claim 10:

Regarding Claim 10, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 9 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose: wherein each electronic document has a native format type, the method further comprising generating a first lock signal in response to the second signal, and in accordance therewith, automatically locking the one or more electronic documents in their native format types, and generating a second lock signal in response to the first signal, and in accordance therewith, automatically converting the one or more electronic documents from their native format types to locked image files (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55 – Fabbio '089 supports notifications in general as a package attribute which reads on a first signal in response to a second signal and a second lock signal in response to a first signal; and combined with Dziewit '214's support of locking reads on locking an electronic document in response to a first signal – also see Dziewit '214: col. 1, lns.

33-60 which outline a generic paper transaction to be automated by Dziwit '214).

Claim 12:

Regarding Claim 12, Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses: a computer-implemented method comprising:

- storing a plurality of alterable electronic documents on a computer system, the plurality of electronic documents (Fabbio '089: col. 2, lns. 56-65); and
- creating a package including one or more of the electronic documents (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that “one or more pieces of information” reads on one or more electronic documents), the package being displayed in a first folder of a graphical user interface (Fabbio '089: col. 3, ln. 58 to col. 4, ln. 12; col. 8, ln. 56 to col. 9, ln. 24).

However, Fabbio '089 does not explicitly disclose:

- automatically locking down the one or more electronic documents in the package when a user transmits a first signal indicating that the package has been transferred from a first phase to a second phase; or
- the electronic documents are associated with a patent application.

Dziwit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziwit '214 discloses: a computer-implemented method of controlling document edits (Dziwit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) comprising: automatically locking down the one or more electronic documents in the package when a user transmits a first signal

indicating that the package has been transferred from a first phase to a second phase (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55). However, Dziewit '214 does not disclose that the electronic documents are associated with a patent application

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to combine the method of Dziewit '214 with the method of Fabbio '089. The motivation to combine is on the same basis as Claim 1 (supra).

It would have been further obvious to a person having ordinary skill in the art to combine the method of Fabbio '089 and Dziewit '214 in combination with the LegalStar '99 disclosure. The motivation to combine is on the same basis as Claim 1 (supra).

Claims 13-16 and 18-19:

Regarding Claims 13-16 and 18-19, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 12 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 13) wherein the first phase is a final draft phase and the second phase is a ready to file phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214 – this reads on the first phase is a final draft phase and the second phase is a ready to file phase);

- (Claim 14) wherein the first phase is a final draft phase and the second phase is a filed phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214 – this reads on the first phase is a final draft phase and the second phase is a filed phase);
- (Claim 15) wherein the first phase is a filed phase and the second phase is a transmitted phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214 – this reads on first phase is a filed phase and the second phase is a transmitted phase);
- (Claim 16) wherein automatically locking includes automatically converting the one or more electronic documents from a first document type to a locked image file (Fabbio: '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);
- (Claim 18) wherein the each electronic document has a native format type, the method further comprising generating a first lock signal in response to the first signal, and in accordance therewith, automatically locking the one or more electronic documents in their native format types, and generating a second lock signal in response to a second signal indicating the package has been transferred from the second phase to a third phase (Fabbio '089: col. 6, lns. 6-8; Dziewit '214: col. 1, lns. 33-59 – note that Fabbio '089 supports notifications in general as a package attribute which applies to an arbitrary business process as described by Dziewit '214), and in

accordance therewith, automatically converting the one or more electronic documents from their native format types to locked image files (Fabbio: '089: col. 12, lns. 19-23; Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);

- (Claim 19) wherein the electronic documents include a provisional patent application specification, non-provisional patent application specification, response to an office action, inventor declaration, assignment, power of attorney, or patent drawings (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

Claim 20:

Regarding Claim 20 Fabbio '089 discloses a means of distributing a package of electronic documents. Specifically, Fabbio '089 discloses:

- storing a plurality of electronic documents on a computer system, each electronic document having a native format type (Fabbio '089: col. 2, lns. 56-65);
- creating a package including one or more of the electronic documents (Fabbio '089: col. 5, lns. 25-38; col. 2, lns. 60-62 – note that "one or more pieces of information" reads on one or more electronic documents);
- generating a first signal indicating that the package is ready to be filed (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating electronic documents are to be filed); and
- automatically transforming the one or more electronic documents from its native format types into a format type that is viewable as it will be printed (Fabbio: '089: col. 12, lns. 19-23).

However, Fabbio '089 does not explicitly disclose:

- displaying the transformed one or more electronic documents to a remote user; or
- that the filing is in a patent office.

Dziewit '214 discloses an authentication and locking means for electronic documents in transmission. Specifically, Dziewit '214 discloses: a computer-implemented method of controlling document edits (Dziewit '214: Abstract – note that locking a document such that no modification can occur, reads on controlling document edits) comprising displaying the transformed one or more electronic documents to a remote user.

However, Dziewit '214 does not explicitly disclose that the filing is in a patent office.

LegalStar '99 discloses electronic forms used in conjunction with filing patents with the U.S. Patent and Trademark Office (LegalStar '99: Note the document titled, "IP LegalForm Patent (TM)").

It would have been obvious to a person having ordinary skill in the art to combine the method of Dziewit '214 with the method of Fabbio '089. The motivation to combine is on the same basis as Claim 1 (supra).

It would have been further obvious to a person having ordinary skill in the art to combine the method of Fabbio '089 and Dziewit '214 in combination with the LegalStar '99 disclosure. The motivation to combine is on the same basis as Claim 1 (supra). Note the automation of the patent filing process as described in the motivation to combine in Claim 1 (supra) suggests that the filing is with a patent office.

Claims 21-22:

Regarding Claims 21-22, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 20 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose:

- (Claim 21) further comprising locking the transformed one or more documents (Dziewit '214: col. 14, lns. 26-32; col. 14, lns. 51-55);
- (Claim 22) further comprising generating a signal indicating that the package can be filed (Fabbio '089: col. 6, lns. 6-8 – Examiner notes that Fabbio '089 supports notifications in general as a package attribute which reads on a first signal indicating that the package can be filed).

Claim 23:

Regarding Claim 23, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 22 (supra). Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose: further comprising entering the package into an outgoing mail queue (Fabbio '089: col. 3, lns. 9-23 – note that targeting an email address for an output for a package reads on targeting an outgoing mail queue).

Claim 24:

Regarding Claim 24, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 23. Additionally, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose further comprising electronically filing the package in a patent office (Dziewit '214: col. 1, lns. 32-59 – note that Dziewit '214 provides for the automation of an arbitrary business process, including electronic filing. Taken in combination with Fabbio '089,

and LegalStar '99, this suggests automating the patent filing process which includes electronically filing the package in a patent office) .

3. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabbio '089, Dziewit '214, and LegalStar '99 in combination in view of the publication, "Design, Implementation, and Evaluation of a Revision Control System" by Tichy, published 1982 (hereafter Tichy '82).

Claims 7 and 17:

Regarding Claims 7 and 17, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 6 and 16 (supra). However, Fabbio '089, Dziewit '214, and LegalStar '99 in combination do not explicitly disclose: further comprising displaying the locked image files in a file history portion of a graphical user interface.

Tichy '82 discloses a revision control system. Specifically, Tichy '82 discloses: further comprising displaying the locked image files in a file history portion of a graphical user interface (Tichy '82: pp. 61-62, section 2.3 - note the file history capability).

It would have been obvious to a person having ordinary skill in the art to combine the file history of Tichy '82 to the Fabbio '089, Dziewit '214, and LegalStar '99 combination. The motivation to combine is suggested by Tichy '82 which discloses the advantage of providing maintainable tracking of changes in a set of documents undergoing constant modification such as that of the Fabbio '089, Dziewit '214, and LegalStar '99 combination (Tichy '82: p. 58, section 1).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fabbio '089, Dziewit '214, and LegalStar '99 in combination in view of the web site www.adobe.com as archived by the WAYBACK MACHINE (TM) (www.archive.org) on January 25, 1999 (hereafter Adobe '99).

Claim 8:

Regarding Claim 8, Fabbio '089, Dziewit '214, and LegalStar '99 in combination disclose all the limitations of Claim 5 (supra). However, Fabbio '089, Dziewit '214, and LegalStar '99 in combination do not explicitly disclose: wherein the locked image file is a locked .pdf file.

Adobe '99 discloses .pdf locking. Specifically, Adobe '99 discloses: wherein the locked image file is a locked .pdf file.

It would have been obvious to a person having ordinary skill in the art to substitute the locked .pdf file of Adobe '99 for the locked image file of the Fabbio '089, Dziewit '214, and LegalStar '99 combination. The motivation to combine is suggested by Adobe '99 which discloses the advantage of providing protection during distribution to legal documents such as the patent documents in the Fabbio '089, Dziewit '214, and LegalStar '99 combination (Adobe '99: p. 1 of 3, section titled, "Protect documents with security controls").

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J.D. Santos whose telephone number is 703-305-0707. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos
August 2, 2004


FRANTZ COBY
PRIMARY EXAMINER